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04-27-04

1631



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: Michael A. Tainsky, et al.

Serial No.: 10/004,587

Group Art Unit: 1631

Filed: 12/04/01

Examiner: CLOW, Lori A.

For: NEOEPITOPE DETECTION OF DISEASE
USING PROTEIN ARRAYS

Attorney Docket No: 0788.00063

RESPONSE

Mail Stop: Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Office Action dated March 24, 2004, Paper Number 0304.

Restriction to one of the following Groups was required under 35 USC §121:

I. Claims 1-4 and 10 drawn to a diagnostic tool and a kit for use in diagnosing a disease, classified in class 422, subclass 50;

II. Claims 5-6, drawn to a combination of markers for diseases, classified in class 435, subclass 174;

III. Claims 7-9, drawn to a method of detecting a combination of markers, classified in class 435, subclass 6;

IV. Claim 11, drawn to epitopes, classified in class 424, subclass 130.1;

V. Claim 12, drawn to a method of detecting disease, classified in

V. Claim 12, drawn to a method of detecting disease, classified in class 435, subclass 7.1;

VI. Claim 13, drawn to a database, classified in class 702, subclass 19;

VII. Claim 14, drawn to a method of selecting indicative epitopes, classified in class 435, subclass 7.1;

VIII. Claim 15, drawn to a method for processing data, classified in class 707, subclass 101;

IX. Claim 16, drawn to a tool for interpreting results of disease screening, classified in class 702, subclass 19;

X. Claims 17-18, drawn to a method of creating any array of markers, classified in class 435, subclass 6; and

XI. Claim 19, drawn to a biochip for detecting presence of disease markers, classified in class 435, subclass 287.2.

Applicants provisionally elect Group III, claims 7-9 for prosecution purposes, with traverse. Applicants hereby conditionally withdraw claims 1-6 and 10-19 from prosecution, without prejudice, and request reconsideration of the restriction requirement.

Applicant(s) traverse the restriction requirement based on the following grounds. It is respectfully submitted that the restriction requirement practice was established to promote efficiency of prosecution in the Patent Office. Groups II, III, V, VII, X and XI are all classified in class 435. More specifically, Groups III, VII, V and X all relate to methods of detecting or selecting specific combinations of markers or epitopes for creating an array of markers that is used to detect disease. Thus, they all relate to the same inventive concept, namely creating an array for the detection of disease. Since all of the groups relate to the same

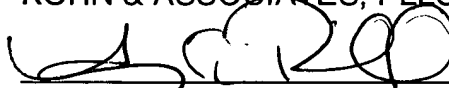
general methodology and are used for similar purposes, it is respectfully submitted that examination of all the claims of these groups can be accomplished in a single application without obviating the purpose behind the restriction requirement practice. Hence, it is respectfully submitted that restriction should not be required and that Applicants have traversed the restriction requirement. However, as stated above, Applicants elect the claims of Group III and provisionally withdraw claims 1-6 and 10-19, without prejudice, pending reconsideration of the restriction requirement.

The Commissioner is authorized to charge any fee or credit any overpayment in connection with this communication to our Deposit Account No. 11-1449.

The application is now in condition for allowance, which allowance is respectfully solicited.

Respectfully submitted,

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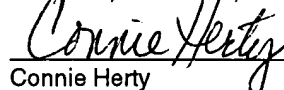
Dated: April 26, 2004

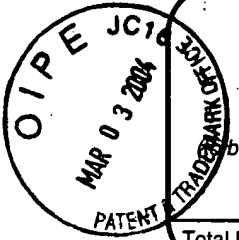

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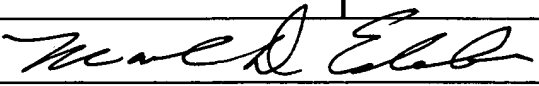
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TRANSMITTAL FORM To be used for all correspondence after initial filing)	Application Number	10/361,533	
	Filing Date	February 10, 2003	
	First Named Inventor	Dan J. Clingman et al.	
	Group Art Unit	2834	
	Examiner Name	Thomas M. Dougherty	
Total Number of Pages in This Submission		Attorney Docket Number	7784-000555

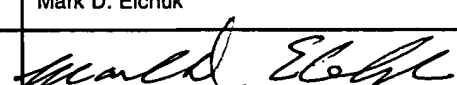
ENCLOSURES (check all that apply)

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Remarks 		The Commissioner is hereby authorized to charge any additional fees that may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 08-0750. A duplicate copy of this sheet is enclosed.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Harness, Dickey & Pierce, P.L.C.	Attorney Name	Mark D. Elchuk	Reg. No.	33,686
Signature					
Date	March 3, 2004				

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I hereby certify that this correspondence is being deposited with the United States Postal Service as express mail in an envelope addressed to: Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450, or facsimile transmitted to the U.S. Patent and Trademark Office on the date indicated below.			
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Signature		Date	March 3, 2004